

REMARKS

Claim Rejections

Claims 1-70 were originally filed in the present case. Claims 1-70 are canceled and claims 71-130 are added in the present amendment. Therefore, claims 71-130 are currently pending.

In the Office Action date June 30, 2004, the Examiner has made a number of rejections. The currently pending rejections are:

- 1) Claims 15, 16, 18, 19, 28, 29 and 44 stand rejected under 35 U.S.C. §112 (second paragraph);
- 2) Claims 1, 2, 3, 6-10, 14-18, 20, 23, 25, 26, 28-31, 33, 35-38, 40, 42, 44, 46-53, 55-57, 61-63, 65 and 67-70 stand rejected under 35 U.S.C. §102(e) as being anticipated by Baker, Jr. et al. (US 6,015,832);
- 3) Claims 1, 3-6, 8-10, 15-23, 27-30, 32-36, 39, 40, 43-53, 60-63, 65, 67, and 68 stand rejected under 35 U.S.C. §102(e) as being anticipated by Schwarz.
- 4) Claims 11-13, 37 and 66 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Baker, et al. (US 6,015,832);
- 5) Claims 24, 41, 54 and 64 are rejected under 35 U.S.C. §103(a) as being unpatentable over Schwarz (US 6,117,415); and
- 6) Claims 58 and 59 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Baker, Jr. et al. (6,015,832).

Each of these grounds of rejection is addressed in detail below. Applicants note that all amendments and canceling of Claims presented herein are made without acquiescing to any of the Examiner's arguments or rejections, and solely for the purpose of expediting the patent application process in a manner consistent with the PTO's Patent

Business Goals (PBG),¹ and without waiving the right to prosecute the amended or canceled Claims (or similar Claims) in the future.

Applicants further note, per the Examiner's request to comment on the priority date (Office Action of June 30, 2004, page 2), that the present application is entitled to the priority date of April 28, 1999 as the present invention claims priority to U.S. Patent Application No. 09/561,111 which was filed within one year of the April 28, 1999 filing date of U.S. Provisional Patent Application No. 60/131,638. In view of the Amendments and arguments made herein, this date has no bearing on the patentability of the claims as the pending prior art references do not teach or suggest all elements of the present claims.

In the present Response to Office Action of June 30, 2004 Applicants have amended the claims to incorporate specific preferred elements. The new claims are fully supported in the specification and do not add new matter. Applicant believes that the pending claims are definite, are not taught by the prior art, and are not obvious. Therefore, claims 71-130 should be passed into allowance.

REJECTIONS

For clarity, the rejections at issue are set forth by number in the order they are herein addressed.

I. THE CLAIMS ARE DEFINITE

The Examiner has rejected Claims 15, 16, 18, 19, 28, 29 and 44 under 35 U.S.C. 112, second paragraph “. . . as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.” (Office Action of June 30, 2004, page 2.) The Examiner argues: “Claims 15, 16, 18, 19, 28, 29 and 44 contain the trademark/trade name “TRITON”, TYLOXAPOL”, “POLYSORBATE” and “TWEEN”. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not

¹ 65 Fed. Reg. 54603 (Sept. 8, 2000).

comply with the requirements of 35 U.S.C. 112, second paragraph.” (Office Action of June 30, 2004, page 2).

Applicants respectfully disagree. A “polysorbate” is any of a class of emulsifiers used in food preparation and in some pharmaceuticals comprising a salt or ester of sorbitol (American Heritage Dictionary of the English Languages: Fourth Edition. 2000). Hence, the term “polysorbate surfactant” of claim 15 is not, as the Examiner contends, either a trademark or a trade name.

In order to further the prosecution of the present case, while not acquiescing to the Examiner’s argument, and retaining the right to prosecute the original claims (or similar claims) in the future, in the present Response to Office Action of June 30, 2004 Applicants have canceled claim 16 (reciting TWEEN 10, TWEEN 40, TWEEN 60 and TWEEN 80), claim 18 (reciting TRITON X-100, X-301, X-165, X-102, and X-20), claim 19 (reciting TYLOXAPOL), claim 28 (reciting TRITON X-100), claim 29 (reciting TWEEN-20), claim 44 (reciting TRITON X-100, and claim 45 (reciting TWEEN-20). Applicants note that the pending claims still encompass such subject matter (while not explicitly reciting the subject matter).

In view of the above, Applicants request that these rejections be withdrawn.

II. THE CLAIMS ARE NOT ANTICIPATED

The Examiner has rejected Claims 1, 2, 3, 6-10, 14-18, 20, 23, 25, 26, 28-31, 33, 35-38, 40, 42, 44, 46-53, 55-57, 61-63, 65 and 67-70 under 35 U.S.C. §102(e) as being anticipated by Baker, Jr. et al. (US 6,015,832), and Claims 1, 3-6, 8-10, 15-23, 27-30, 32-36, 39, 40, 43-53, 60-63, 65, 67, and 68 under 35 U.S.C. §102(e) as being anticipated by Schwarz.

The Federal Circuit has stated the relevant analysis for anticipation as follows:

"A claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference."²

Applicants respectfully submit that neither of the references cited by the Examiner teach each and every element as set forth in the claims.

A. BAKER DOES NOT ANTICIPATE THE CLAIMS

In the present Office Action the Examiner argues: "Baker meets the limitations of the claims." (Office Action of June 30, 2004, page 4).

Applicant respectfully disagrees. However, in order to further the prosecution of the present case, while not acquiescing to the Examiner's argument, and retaining the right to prosecute the original claims (or similar claims) in the future, Applicant has amended claims 71, 93, 104, 115, 120 and 121 to recite "a halogen-containing compound". Baker does not teach a halogen-containing compound.

In view of the above, Applicants request that these rejections be withdrawn.

B. SCHWARZ DOES NOT ANTICIPATE THE CLAIMS

In the present Office Action the Examiner argues: "Schwarz meets the limitations of the claims." (Office Action of June 30, 2004, page 5).

Applicant respectfully disagrees. However, in order to further the prosecution of the present case, while not acquiescing to the Examiner's argument, and retaining the right to prosecute the original claims (or similar claims) in the future, Applicants have amended claims 71, 93, 104, 115, 120 and 121 to recite "an alcohol". Schwarz does not teach an alcohol.

Moreover, Applicants respectfully point out to the Examiner that Schwarz is not prior art. Schwarz was filed June 17, 1999. The present application is a Continuation-in-Part of U.S. application No. 09/561,111, filed April 28, 2000, which claims priority to U.S. provisional application No. 60/131,638, filed April 28, 1999. Hence, even if

² *Verdegaal Bros. V. Union Oil of California*, 2 USPQ2d 1051, 1053 (Fed.Cir. 1987)

Schwarz did teach each and every element of the present claims (and it does not), it does not anticipate the present claims.

In view of the above, Applicants request that these rejections be withdrawn.

III. THE CLAIMS ARE NOT OBVIOUS

A *prima facie* case of obviousness requires the Examiner to cite to a reference which a) discloses all the elements of the claimed invention, b) suggests or motivates one of ordinary skill in the art to combine the claim elements to yield the claimed invention, and c) provides a reasonable expectation of success should the claimed combination be carried out. Failure to establish any one of these three requirements negates a finding of a *prima facie* case and, without more, entitles the Applicants to allowance of the claims in issue. (MPEP).

A. BAKER DOES NOT RENDER CLAIMS 11-13, 37 AND 66 OBVIOUS

In the Office Action of June 30, 2004 the Examiner has rejected claims 11-13, 37 and 66 under 35 U.S.C. §103(a) as allegedly being obvious in view of Baker, et al. (US 6,015,832). (Office Action of June 30, 2004, page 6). The Examiner argues: “Baker discloses the instant anti-microbial composition. . . . Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare and use the oil-in-water emulsion of Baker.” (Pages 5-6)

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. Baker does not disclose all elements of the claimed invention. For example, Baker does not teach or suggest a halogen-containing compound.

In view of the above, Applicants request that the rejection under 35 USC §103(a) for alleged obviousness be withdrawn.

B. SCHWARZ DOES NOT RENDER CLAIMS 24, 41, 64 AND 64 OBVIOUS

In the Office Action of June 30, 2004 the Examiner has rejected claims 24, 41, 54 and 64 under 35 U.S.C. §103(a) as allegedly being obvious in view of Schwarz et al. (US 6,117,415). (Office Action of June 30, 2004, page 6). The Examiner argues: "Schwarz discloses the instant oil-in-water composition. . . . Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare the emulsion of Schwarz and use it as an oral care product." (Page 6).

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. Schwarz does not disclose all elements of the claimed invention. For example, Schwarz does not teach or suggest an alcohol. Nor is Schwarz prior art.

In view of the above, Applicant requests that the rejection under 35 USC §103(a) for alleged obviousness be withdrawn.

C. BAKER DOES NOT RENDER CLAIMS 58 AND 59 OBVIOUS

In the Office Action of June 30, 2004 the Examiner has rejected claims 58 and 59 under 35 U.S.C. §103(a) as allegedly being obvious in view of Baker, et al. (US 6,015,832). (Office Action of June 30, 2004, page 6). The Examiner argues: "Baker discloses biologically assaying for the effectiveness of the emulsion composition but does not disclose that the product is for sale. . . . Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare and modify the emulsion of Baker as necessary in the evaluation of the emulsion for effectiveness." (Pages 6-7).

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. Baker does not disclose all elements of the claimed invention. For example, Baker does not teach or suggest a halogen-containing compound.

In view of the above, Applicants request that the rejection under 35 USC §103(a) for alleged obviousness be withdrawn.

PATENT

U.S. Patent Application No. **09/751,059**

Attorney Docket No. **UM-04491**

Double Patenting

A terminal disclaimer in compliance with 37 C.F.R. §1.321 has been filed to overcome a provisional rejection based on nonstatutory double patenting, and evidence has been provided showing that the conflicting application and issued patents are commonly owned with this application in accord with 37 C.F.R. §1.120(b).

Conclusion

All grounds of rejection of the Office Action of June 30, 2004 have been addressed and reconsideration of the application is respectfully requested. It is respectfully submitted that Applicant's claims as amended should be passed into allowance. Should the Examiner believe that a telephone interview would aid in the prosecution of this application Applicant encourages the Examiner to call the undersigned collect at (608) 218-6900.

Dated: 9/14/04



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